

REMARKS

These Remarks are made in response to the Final Office Action of July 1, 2010 ("Final Office Action"). Claims 1-4, 6, 7, 9-19, 21, 22, 24-34, 36, 37, and 39-45 are pending in this application, of which claims 1, 16, and 31 are independent. By this Amendment, Applicant has amended claim 1, 16, and 31. No new matter has been added.

In the Final Office Action, the Examiner took the following actions:

- (i) rejected claims 1-45 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement;
- (ii) rejected claims 1-4, 6-7, and 9-15 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter;
- (iii) rejected claims 1-7, 12-22, 27-37, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,901,214 ("*Shaffer*"), in view of U.S. Patent Pub. No. 2004/0211834 ("*Fleckenstein*"), and in further view of U.S. Patent Pub. No. 2006/0031213 ("*Wilson*"); and
- (iv) indicated claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form including all of the limitations of each claim's base claim and any intervening claims.

Applicants thank the Examiner for indicating that claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form. Nevertheless, Applicants respectfully traverse the rejections and objections as follows.

I. Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-45 were rejected under 35 U.S.C. § 112, first paragraph, for containing a negative limitation that allegedly is not explicitly supported by the specification. For example, claim 1 previously recited “creating a normal delivery point code when the delivery data does not include a secondary element.”

Applicants traverse the rejection because the specification does, in fact, provide explicit support for this subject matter. For example, FIG. 4 contains a flow chart that includes a decision box 420 stating “Does the delivery data include a secondary element?” If the answer is “no,” then box 440 states “Create a normal delivery point code based upon the delivery data.” Additionally, paragraph [007] states in part that “a house at 123 Main Street, Osage City, KS 66523-1439 may have a normal delivery point code comprising 66523-1439-23.” This example is distinguished from “if there were several apartments at the same address...” Specification at [007]. These examples, among others, explicitly support the above claim language.

Consequently, the Examiner should withdraw the 35 U.S.C. § 112, first paragraph, rejection.

II. Rejections Under 35 U.S.C. § 101

Claims 1-4, 6-7, and 9-15 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Final Office Action states that the method steps are not tied to a particular machine or apparatus. Final Office Action at 3. Applicants respectfully disagree. However, to advance prosecution, Applicants have amended claim 1 to recite that a “processor” performs various steps,

rendering the 35 U.S.C. § 101 rejections moot. Consequently, the Examiner should withdraw the 35 U.S.C. § 101 rejections.

III. Rejections Under 35 U.S.C. § 103(a)

Applicants also respectfully traverse the § 103(a) rejections. The Final Office Action does not establish a *prima facie* case of obvious with regard to claims 1-4, 6, 7, 9-19, 21, 22, 24-34, 36, 37, and 39-45.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Final Office Action does not properly determine the scope and content of the prior art or ascertain the differences between the claims and the prior art. Accordingly, it does not clearly articulate a reason why the prior art would have rendered the claims obvious to one of ordinary skill in the art.

A. The cited references do not teach or suggest that “the alternate delivery point code contains the same number of digits as the normal delivery point code [and] ... is specific to the particular location at the delivery point.”

Amended independent claims 1, 16, and 31 recite, among other things, “the alternate delivery point code contains the same number of digits as the normal delivery point code [and] ... is specific to the particular location at the delivery point.” This amendment is supported throughout the specification, as is apparent, for example, by comparing the delivery point codes of Figures 1 and 2 and following steps, for example, in Figure 4. The cited references do not teach or suggest this subject matter. The Examiner has correctly acknowledged that *Shaffer* and *Wilson* do not teach this subject matter.

Instead, the Examiner cites *Fleckenstein* for this subject matter. See Final Office Action at 6-7. However, *Fleckenstein* is deficient for at least two reasons. First, the “item code” in *Fleckenstein* is not analogous to a “normal delivery point code,” as claimed by Applicants. In fact, the “item code” does not pertain to the delivery location whatsoever, and instead appears to be assigned to each delivered item as a way to track the delivery of the item. This is presumably why the item code is read after

delivery to the first location, and before sending it on to the alternate location specified by the alternate delivery code. *Fleckenstein* at [0015]. (This is also the reason why the item code does not change even when routed to a different location -- because it is still the same item.)

Rather than using the item code to specify a location, *Fleckenstein* instead appears to use a "delivery notice code" to specify a primary location (*Fleckenstein* at [0008]) and a "unique alternate delivery code" to specify a second (and different) location for delivery when the recipient is unavailable at the primary delivery location. *Fleckenstein* at [0013]. According to *Fleckenstein*, a unique "item code" is assigned for "each of the plurality of items" associated with the "delivery notice code" (*Fleckenstein* at [0008]), leaving no reason whatsoever for the item code to also specify the delivery location.

Because the item code in *Fleckenstein* does not pertain to the delivery location, the fact that "the item code is never changed" (Final Office Action at 7) is not suggestive in any way that "the alternate delivery point code contains the same number of digits as the normal delivery point code."

Second, the "alternate delivery code" of *Fleckenstein* is not "specific to the particular location at the delivery point," as claimed. Instead, it specifies a completely different delivery point that is used when the recipient is unavailable at the first delivery point. *Fleckenstein* at [0005], [0014]. Therefore, for an additional reason, *Fleckenstein* does not teach or suggest all recitations of Applicants independent claims 1, 16, and 31.

- B. The cited references do not teach or suggest that “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data.”**

Amended independent claims 16 and 31 substantially recite that “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data.” Applicants raised this argument in the prior Reply to Office Action of April 15, 2010, but it does not appear to be addressed in the Final Office Action. Although at pages 7-8 of the Final Office Action acknowledge that this subject matter is not taught or suggested by *Shaffer* or *Fleckenstein*, the Final Office Action again cites a passage from *Wilson* that Applicants have already shown is silent with regard to the claimed subject matter. The cited paragraph is replicated below:

The above-incorporated parent application "METHOD AND SYSTEM FOR STORING AND RETRIEVING DATA USING HASH-ACCESSED MULTIPLE DATA STORES" provides a secured data store that may contain address information and be distributed to vendors that are not agents supervised by the USPS. However, in order to use the method and system described in the above-referenced patent application, access information must be standardized and filtered (pre-processed) so that the information placed in the data store may be retrieved. While the above-referenced patent application describes a level of pre-processing that obtains an 11-digit delivery point code (DPC) that is used to access the data stores and retrieve associated address information, the DPC must be obtainable from user input or other data entry, such as records in other data stores, before the address information can be accessed.

Wilson at [0006].

This paragraph does not teach or suggest that “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data,” as claimed. The statement “a level of pre-processing that obtains an 11-digit delivery point code (DPC) that is used to access the

data stores and retrieve associated address information” does not constitute or suggest Applicants’ claimed subject matter. Indeed, as previously asserted, it has nothing to do with “creating the alternative delivery point code” or “converting at least one digit of numeric data in the secondary element into different numeric data,” as claimed. The rest of *Wilson* is also silent with regard to this subject matter.

Consequently, no combination of *Shaffer*, *Fleckenstein*, and *Wilson* discloses, teaches or suggests “creating the alternative delivery point code ... includes converting at least one digit of numeric data in the secondary element into different numeric data,” as recited in amended independent claims 16 and 31. Therefore, at least this additional basis for allowance exists for those claims.

C. No *prima facie* case of obviousness

In view of at least these shortcomings of *Shaffer* and *Wilson*, the Office Action does not properly determine the scope and content of the prior art or explain why the differences between the cited references and amended claims 1, 16, and 31 would have been obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 31, and the rejections under 35 U.S.C. § 103(a) must be withdrawn. For the same reasons, claims 2-4, 6-7, 9-15, 17-19, 21-22, 24-30, 32-34, 36-37, and 39-45¹ are also allowable at least due to their dependence from independent claims 1, 16, and 31.

¹ Accordingly, dependent claims 9-11, 24-26, 29-30, 32-34, and 36-41 do not depend on a properly rejected base claim, and Applicants submit that the objection to these claims is overcome for at least these reasons.

Conclusion²

In view of the foregoing remarks, Applicants submit that the pending claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request that the Examiner reconsider and withdraw the rejections to the pending claims and pass this application to issue.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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² It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.